

**1<sup>st</sup> Amended Responsive Amendment**

Application Serial No. 10/789,698

Attorney Ref. No. Carroll-001

**REMARKS**

Claims 1-19 and 23 are currently pending in this application. In the Office Action mailed August 1, 2006 (the "Office Action"), claims 1-19 and 23 were rejected. Through this amendment, claims 1, 10, 11-13, 18, 19, 20, 21, 22, 23 have been amended, and claims 9, 16, and 17 have been withdrawn. Applicant respectfully requests favorable consideration of the present application in light of the amendments to the claims and the following remarks.

**I. Abstract – MPEP §608.01(b)**

The abstract was objected by the Office Action under MPEP §608.01(b) for containing phrases capable of implication. As such, applicant has included an amended abstract with this response. Applicant believes the amended abstract to be proper, and requests favorable consideration in light of the amendments.

**II. Specification – 37 CFR 1.75(d)(1)**

The disclosure was objected to by the Office Action because of the following informalities: on page 9, line 3, "pushes" should be "pushed" and the claims heading should be removed from the bottom of page 15. As such, suitable amendments are included herewith to address the Examiner's concerns. Applicant believes the amendments to be proper, and requests favorable consideration in light of the amendments.

The specification was objected to by the Office Action under 37 CFR 1.75(d)(1) for failing to provide a proper antecedent basis for the claimed subject matter. Specifically, the

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specification was objected to for failure to provide antecedent basis for the material of claims 6 and 7. Applicant respectfully traverses this objection as set forth below.

Under 37 CFR 1.75(d)(1), “the claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” Applicant respectfully contends that the specification does in fact provide an antecedent basis for claim 6 and claim 7.

Claim 6 has been amended to read: “The front barrel of claim 1, where the inner circumference of the front barrel (207) is about the same circumference or slightly **greater** than the outer circumference around the front end (103) of valve (206).” As such, applicant respectfully contends that the specification provides an antecedent basis for the amended claim, as figures 1, 2, 17, and 18 all depict this size configuration whereby the front end (103) is approximately the same size, or slightly smaller, than the inner circumference of the front barrel (207).

Claim 7 reads: “The valve (206) of claim 1, where the front end (103) is separated from the inner circumference of the front barrel (207) by an open space.” Applicant contends that an antecedent basis is in fact provided for claim 7, in that figures 1, 2, 17, and 18 depict an area of “open space” between the front end 103 of the valve 206 and the inner circumference of the front barrel 207. The “open space” between the front end 103, and the valve 206 is not labeled by a reference number, but it is clear that such a space is intended, in that areas where contact

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between parts is envisioned (as between the back end 104 of the valve 206 and the inner circumference of the front barrel 207) contact is clearly depicted.

Thus, Applicant respectfully requests that the objection to the specification be withdrawn. The specification is believed to be in proper condition for allowance and an indication of such is hereby earnestly solicited.

**III. Claim Rejections – 35 USC §112**

Claims 8-20 and 23 were rejected by the Office Action under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, examiner recites the terms “the leading section”, “the cartridge”, “the tip”, “the opening”, and “the second leading section” as being indefinite and requiring definition.

As the claims must be read in light of the specification and common usage, and an applicant may be his own lexicographer, the applicant respectfully requests that the examiner find that the specification provides a proper definition of the preceding terms. Paragraph 51 of the specification, p. 13, delineates the term “leading section” as the part of the elongated portion 105, of the cartridge (paragraph 38, p. 9). As the term “leading” is commonly defined as “to go first” (*Random House Unabridged Dictionary, 2006*) the term “leading section” clearly means the section of the cartridge which goes first – that is to say, the first part of the cartridge to pass through the opening 203 of the writing utensil. This rationale also applies to the term “second

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leading section,” which may clearly be understood to mean that part of the cartridge which passes through the opening 203 after the first leading section, but before the rest of the cartridge.

The term “the cartridge” is defined in specification paragraph 38, p. 9, as “adapted to enclose a feeder [which] store[s] a writing fluid.” This is a clear definition of the term “the cartridge” to mean: a device adapted to enclose the feeder which stores the writing fluid.

The term “the tip” is defined on p. 8, paragraph 35, as a part “within the enclosure” in the retracted position, in which “the fluid stored in the feeder 107 conveys through” during the writing process. Additionally, on p. 9, paragraph 36, the term is defined as the part which the user “[applies] the fluid to a surface.” The nature of the fluid/tip interaction is further defined in paragraph 38, which states that ‘the capillary relationship among the feeder 107 and the tip 101 causes the writing fluid to convey from the feeder 107 to the tip 101. As such, it is clear that the tip 101 is the part which applies fluid, acquired from the feeder, to the surface to be written upon.

The term “the opening (203)” is used in conjunction with “of the front barrel (207)” to provide a clearly defined part of the writing instrument. Plain language aside, which blatantly calls for a meaning of just that: “the opening of the front barrel”, p. 10 of the specification delineates that the opening 203 “allow[s] the tip 101 to move between a protracted and retracted position,” and that “the tip 101 extend[s] through the opening 203.” As such a definition of “the opening” is clear in that it defines a part of the front barrel through which the tip may extend.

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**IV. Double Patenting**

The examiner rejected claim 9 under a nonstatutory obviousness-type double patenting for claims not patentably distinct from reference claims 1, 15, 19, 23, and 46 found in copending Application number 10/864,096. As applicant hereby withdraws claim 9, applicant believes this amendment renders the double patenting objection moot.

**V. Claim Rejections – 35 USC § 102(e)**

**A. Lewis**

Claims 1-3, 6-11, 13, 17, 19, and 23 were rejected by the Office Action under 35 USC § 102(b) as being anticipated by U.S. Patent 7,059,796 to Lewis et al ("Lewis"). Applicant respectfully traverses this rejection as set forth below.

In order for a reference to anticipate the present claimed invention under 35 USC 102(b), it must be shown that each and every element of the claim can be found in the reference. If it can be shown that one element of the claim is missing or not met by the cited reference, the rejection must be withdrawn as inappropriate.

Claim 1, as amended, recites a retractable writing tool comprising a rear barrel and a front barrel having an opening and a tip capable of moving between a retracted position and a protracted position; a feeder capable of conveying fluid to the tip and a valve having a front end and a back end, where the front end has a round face **with a concave shape profile at the point where the tip is to exit** and a slit, the front end is adjacent to the opening of the front barrel so

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that in the retracted position the tip is between the front end and the back end substantially sealed from outside air to substantially prevent the writing fluid from evaporating to the outside air, and preventing the release of vapor fluid from within the enclosure when the tip is in a retracted position, where in the protracted position, the tip extends through the slit of the valve and opening of the front barrel, where the valve is made of silicone.

The Lewis reference appears to be silent with regard to at least one element found in amended claim 1 of the claimed invention. Among other voids, the Lewis reference does not disclose the claim 1 component whereby “the front end [of the valve] has a round face **with a concave shape profile at the point where the tip is to exit.**”

Although Lewis discloses a retractable writing instrument having a valve whereby “a portion of the inner side surface of the valve has a concave profile” (Office Action, p 5), Lewis does not disclose an instrument whereby the valve is concave at the point where the tip is to exit. As depicted in Figs. 2 and 3, Lewis clearly discloses a device having a convex profile at the point where the tip is to exit. The only concave portion of the Lewis valve is found on the lateral sides, parallel to the writing tip. This distinction is pivotal, as applicant contends that the concave nature of applicant’s valve provides for greater sealing capacity, and thereby less loss of writing fluid vapors, than the convex nature of the Lewis design.

Because the Lewis reference is silent with respect to at least one element of amended claim 1, it is respectfully requested that the rejection of claim 1 in the Office Action be

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withdrawn. Claims 1 is believed to be in proper condition for allowance and an indication of such is hereby earnestly solicited.

Claims 2-3, 6-8, 10-11, 13-27, 19, and 23, being dependent upon and further limiting independent claim 1, should be deemed allowable for the reasons set forth in support of the allowability of claim 1, as well as the additional features they contain. Claim 9 has been withdrawn.

**B. Waldinger**

Claims 1-3, 6-11, 13-17, 19, and 23 were also rejected by the Office Action under 35 USC § 102(b), as being anticipated by U.S. Patent No. 5,022,773 to Waldinger, et al ("Waldinger"). Applicant respectfully traverses this rejection as set forth below.

Claim 1, as amended, recites A retractable writing tool comprising a rear barrel and a front barrel having an opening and a tip capable of moving between a retracted position and a protracted position; a feeder capable of conveying fluid to the tip and a valve having a front end and a back end, where the front end has a round face **with a concave shape profile at the point where the tip is to exit** and a slit, the front end is adjacent to the opening of the front barrel so that in the retracted position the tip is between the front end and the back end substantially sealed from outside air to substantially prevent the writing fluid from evaporating to the outside air, and preventing the release of vapor fluid from within the enclosure when the tip is in a retracted position, where in the protracted position, the tip extends through the slit of the valve and opening of the front barrel, where the valve is made of silicone.

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The Waldinger reference appears to be silent with regard to at least one element found in amended claim 1 of the claimed invention. Similar to the Lewis reference, the Waldinger reference does not disclose the claim 1 component whereby “the front end [of the valve] has a round face with a concave shape profile at the point where the tip is to exit.”

Although Waldinger discloses a retractable writing instrument having a valve whereby “a portion of the inner side surface of the valve has a concave profile” (Office Action, p 5), Waldinger does not disclose an instrument whereby the valve is concave at the point where the tip is to exit. As depicted in Figs. 2 and 3, Waldinger clearly discloses a device having a convex profile at the point where the tip is to exit. The only concave portion of the Waldinger valve is found on the lateral sides, parallel to the writing tip. This distinction is pivotal, as applicant contends that the concave nature of applicant’s valve provides for greater sealing capacity, and thereby less loss of writing fluid vapors, than the convex nature of the Waldinger design.

Because the Waldinger reference is silent with respect to at least one element of amended claim 1, it is respectfully requested that the rejection of claim 1 in the Office Action be withdrawn. Claims 1 is believed to be in proper condition for allowance and an indication of such is hereby earnestly solicited.

Claims 2-3, 6-8, 10-11, 13-27, 19, and 23, being dependent upon and further limiting independent claim 1, should be deemed allowable for the reasons set forth in support of the allowability of claim 1, as well as the additional features they contain. Claim 9 has been withdrawn.

**C. Blaustein**

Claims 1, 6, 9, 17, and 19 were also rejected by the Office Action under 35 USC § 102(b), as being anticipated by U.S. Patent No. 6,033,141 to Blaustein, et al ("Blaustein"). Applicant respectfully traverses this rejection as set forth below.

Claim 1, as amended, recites A retractable writing tool comprising a rear barrel and a front barrel having an opening and a tip capable of moving between a retracted position and a protracted position; a feeder capable of conveying fluid to the tip and a **valve having a front end and a back end**, where the front end has a round face with a concave shape profile at the point where the tip is to exit and a slit, the front end is adjacent to the opening of the front barrel **so that in the retracted position the tip is between the front end and the back end substantially sealed from outside air to substantially prevent the writing fluid from evaporating to the outside air**, and preventing the release of vapor fluid from within the enclosure when the tip is in a retracted position, where in the protracted position, the tip extends through the slit of the valve and opening of the front barrel, where the valve is made of silicone.

The Blaustein reference appears to be silent with regard to at least one element found in amended claim 1 of the claimed invention. Among other voids, the Blaustein reference does not disclose the claim 1 component whereby "**in the retracted position the tip is between the front end and the back end substantially sealed from outside air to substantially prevent the writing fluid from evaporating to the outside air**"

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Although Lewis discloses a retractable writing instrument having a concave valve, Blaustein does not disclose an instrument whereby the valve has a separate front and back end, so that while the pen is in the retracted position the tip remains **within** the valve – thereby sealing the tip from outside air, and preventing the evaporation of writing fluid. As depicted in Figs. 1 and 2, Blaustein clearly discloses a device having a convex valve, but this valve does not envelop the writing tip when the tip is in the protracted position. The valve merely seals the body of the writing device from the outside air, it does not seal the tip within the valve, which applicant's device clearly does. This distinction is pivotal, as applicant contends that the sealing of the tip within the valve prevents evaporation of writing fluid to a degree not attainable by Blaustein's device.

Because the Blaustein reference is silent with respect to at least one element of amended claim 1, it is respectfully requested that the rejection of claim 1 in the Office Action be withdrawn. Claims 1 is believed to be in proper condition for allowance and an indication of such is hereby earnestly solicited.

Claims 6, 17, and 19, being dependent upon and further limiting independent claim 1, should be deemed allowable for the reasons set forth in support of the allowability of claim 1, as well as the additional features they contain. Claim 9 has been withdrawn.

**VI. Claim Rejections – 35 USC § 103(a)**

Claim 4, 5, and 18 was rejected under 35 USC § 103(a) as being unpatentable over Waldinger. Applicant respectfully traverses this rejection as set forth below.

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To establish a *prima facie* case of obviousness under 35 USC § 103(a) in view of a reference or combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Finally, in determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

Claims 4, 5, and 18 depend from and further limits independent claim 1. As presented earlier, Waldinger does not anticipate Applicant's amended claim 1. Assuming *arguendo* the materials disclosed by applicant were obvious in light of Waldinger (though applicant expressly does not concede this point) there is nothing in Waldinger to suggest to one skilled in the art the invention of a retractable writing instrument having a concave-shaped valve at the point where the tip is to exit the valve. As such, Applicant respectfully submits that there is no reason why one skilled in the art would be led to the present invention as claimed based on the prior art disclosed in Waldinger. Applicant therefore respectfully requests a withdrawal of a finding of obviousness under 35 USC § 103 with respect to these claims.

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Claim 12 was rejected under 35 U.S.C. 103(a) as being unpatentable over Waldinger in view of Zepell. Claim 12 depends from and further limits claim 1. Applicant respectfully traverses this rejection as set forth below. As noted above, nothing in Waldinger suggests the invention of a retractable writing instrument having a concave-shaped valve at the point where the tip is to exit the valve. Applicant respectfully contends that nothing in Zepell suggests that the valve of Waldinger have a concave shape at the point where the tip is to exit the valve, and as such applicant requests that this objection be withdrawn.

Claims 2-5, 16, and 18 were rejected under 35 USC § 103(a) as being unpatentable over Blaustein. Claims 4, 5, and 18 depend from and further limits independent claim 1. Applicant respectfully traverses this rejection as set forth below. Similar to the argument made above for traversing the Waldinger reference, Blaustein does not anticipate Applicant's amended claim 1, and though the materials disclosed by applicant may be obvious in light of Blaustein (though applicant expressly does not concede this point) there is nothing in Blaustein to suggest to one skilled in the art the invention of a retractable writing instrument having a valve which holds the writing tip within the front and back end of the valve while the tip is in the retracted position. Applicant therefore respectfully requests a withdrawal of a finding of obviousness under 35 USC § 103 with respect to these claims.

**CONCLUSION**

The foregoing amendment has been submitted to place the present application in condition for allowance. Favorable reconsideration and allowance of the claims in this application is respectfully requested. In the event that there are any questions concerning this

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Amendment or the application in general, the Examiner is cordially invited to telephone the undersigned attorney so that prosecution may be expedited.

Respectfully submitted,

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